IN THE

Supreme Court of the United States

OCTOBER TERM, 1949.

No. 19.

TODD C. FAULKNER, *Petitioner,*

v.

JOHN T. GIBBS, *Respondent.*

BRIEF OF RESPONDENT IN OPPOSITION TO PETITIONER'S PETITION FOR REHEARING.

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In view of the content of the present petition, which merely reiterates arguments previously advanced to this Court in the petition for certiorari, the briefs and oral argument, it would appear that no reply is necessary.

In order, however, to point up the fact that this Court has, by its opinion, set at rest the conflict of views which resulted from the *Halliburton* opinion we present the following observations.

Contrary to petitioner's assertions, this Court's *Per Curiam* decision has clarified the confusion caused by the *Halliburton* case. Thus, the decision of this Court is in strict harmony with the time-honored doctrine so clearly

elaborated upon in the *Paper Bag* case, to the effect that a patent shall be sustained where patentability rests alone upon a new combination of elements, as contra-distinguished from a situation wherein the *sole* invention resides in an element *per se*.

It is now perfectly clear from the decision in this case that it is proper for an inventor to claim his new combination of elements by employing terms which will embrace a fair range of equivalents of the elements he has disclosed, irrespective of whether all the elements are old or one or more are novel.

Indeed, if the law were otherwise nearly all combination patents would be worthless, for the reasons stated by Judge Learned Hand in the recent decision of *Philip A. Hunt Company* v. *Mallinckrodt Chemical Works* (Decided October 28, 1949) 83 USPQ 277:

> ". . . If the claims were limited to the 'concise and exact terms' in which the specifications ordinarily describe a single example of the invention, few, if any, patents, would have value, for there are generally many variants well-known to the art, which will at once suggest themselves as practicable substitutes for the specific details of the machine or process so disclosed. It is the office of the claims to cover these, and it is usually exceedingly difficult, and sometimes impossible, to do so except in language that is to some degree 'functional'; for obviously it is impossible to enumerate all possible variants. Indeed, some degree of permissible latitude would seem to follow from the doctrine of equivalents, which was devised to eke out verbal insufficiencies of claims. . . ."

The petition for rehearing should, accordingly, be denied.

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